

REMARKS

This Amendment is in response to the Office Action mailed November 25, 2003, having a three (3) month shortened statutory period for reply.

Claims 1-17 are pending and claims 1, 3-6 and 12 have been rejected in this application. All claim amendments are reflected in the Listing of Claims section (on pages 2-4).

Applicant requests consideration and entry into the record of the following amendments and remarks.

Rejection Under 35 U.S.C. §103(a)

Claims 1, 3-6 and 12 are rejected under 35 U.S.C. §103(a) as being obvious over co-pending U.S. Appln. Serial No. 10/023,471 ("U.S. '471 Appln."), Filed Feb. 26, 2002, now U.S. Patent Appln. Pub. No. 2002/0147334 A1, Pub. Date: October 10, 2003.

The Examiner states that the U.S. '471 Appln., which has a common inventor with the present application, as based upon a presumption of future publication or patenting of the conflicting application, which would constitute prior art under 35 U.S.C. 102(e).

Applicant respectfully traverses the above-identified rejection and requests reconsideration for the following reasons.

Applicant respectfully submits that:

U.S. '471 Appln, which was **filed on February 26, 2002**, is a continuation of U.S. Appln. Serial No. 09/623,827, filed September 8, 2000, which is a U.S. 371 application based on PCT/US99/05232, **filed on March 10, 1999**; and that

the present application, U.S. Appln. Serial No. 10/220, 675 ("U.S. '675 Appln."), filed on **September 7, 2000**, is a U.S. 371 Application based upon PCT/US00/24513, which claims priority to U.S. Prov. Appln. No. **September 7, 1999**.

In light of the forgoing information, the U.S. '471 Appln filed on February 26, 2002 and derives priority back to March 10, 1999, does not have an earlier effective filing date or priority date, but a later U.S. filing and priority date than the present application U.S. '675 Appln, which was filed on September 7, 2000 and has a priority date of September 7, 1999.

Based upon the foregoing, the U.S. '471 Appln, which has a common inventor with the present application, also does not have an earlier effective U.S. filing date and could not constitute prior art under 35 U.S.C. 102(e), even though it is now a published U.S. application.

In light of the above, applicant requests that the above rejection under 35 U.S.C. §103(a) be withdrawn.

Claims 1, 3-6 and 12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Miller et al., U.S. Appln. Serial No. 10/023,471 ("U.S. '471 Appln."), Filed Feb. 26, 2002, now U.S. Patent Appln. Pub. No. 2002/0147334 A1, Pub. Date: October 10, 2003.

Under 35 U.S.C. § 103, "a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 . . . , if the difference between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said matter pertains"

In light of the above and discussion *supra* with regard to Miller et al., the U.S. '471 Appln. cannot be considered as prior art, nor render the present invention obvious as the subject matter would not have been obvious at the time the invention was made to a person having ordinary skill in the art to which the instant invention pertains as the U.S. '471 Appln has a later U.S. effective filing date (i.e., filed on February 26, 2002 and derives priority back to March 10, 1999) than that of the present application U.S. '675 Appln (i.e., which was filed on September 7, 2000 and has a priority date of September 7, 1999).

In light of the above, applicant requests that the above rejection under 35 U.S.C. §103(a) be withdrawn.

Rejection Under 35 U.S.C. §112

Claim 12 is rejected under 35 U.S.C. §112, 2nd para., for being indefinite and for failing to particularly point out and distinctly claim the invention. The Examiner states that claim 12 fails to recite "an effective amount of active ingredient".

Claim 12 has been amended to recite "a method of treating osteoporosis which comprises administering to a subject in need thereof a therapeutically effective amount of a compound according to claim 1."

In light of the above, applicant requests that the above rejection under 35 U.S.C. §112 (a) be withdrawn.

CONCLUSION

In view of the above amendments and remarks, applicant believes that the claims of the present application are in condition for allowance and is earnestly solicited .

If any additional fees or charges are required authorization is hereby granted to charge any necessary fees to Deposit Account No. 19-2570 accordingly.

Should the Examiner have any questions or wish to discuss any aspect of this case, the Examiner is encouraged to call the undersigned attorney at the number below.

Respectfully submitted,



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